

K-1775
PATENT

In re Application of Montgomery, Jr.)
Serial No. 09/742,715) Art Unit 3673
Filed: December 20, 2000)
RESPONSE TO THE FINAL OFFICE ACTION OF JANUARY 30, 2004

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Remarks**Introduction**

This Response is responsive to the FINAL Office Action mailed on January 30, 2004.

By this Response, applicant submits that the finality of this Office Action is premature. Applicant also submits that even though certain claims (i.e., 9, 13, 14, 22 and 24) have been allowed, the rejected claims are also allowable for the reasons set forth hereinafter.

Applicant thus respectfully solicits the removal of the rejections and the issuance of a Notice of Allowability and Notice of Issue Fee Due in the above patent application.

The Finality of the Office Action is Premature

MPEP 706.07 requires that before a final rejection is in order that, "... a clear issue should be developed between the examiner and applicant." See Page 700-71. MPEP 706.07 further says that while the rules no longer give to an applicant the right to, "... amend as often as the examiner presents new references or reasons for rejection, ...", present practice does not sanction hasty and ill-considered rejections. *Id.* Further, MPEP 706.07 says that the examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. See Page 700-72.

In this application, it appears that not until the present final Office Action has the applicant had the chance to address the '012 Patent to Krekeler et al. and the '550 Patent to Beebe. Applicant submits that it is unfair for the patent examiner to make this action final since, at least as to the '012 Patent to Krekeler et al. and the '550 Patent to Beebe, applicant has not had the opportunity for a full and fair hearing prior to making the rejection final.

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For the above reasons, applicant requests that the patent examiner remove the final status of the Office Action of January 30, 2004.

Paragraph 2- Rejection under 35 USC §112, 2nd ¶

Applicant has amended claim 30 to provide antecedent basis for the term “cavity bore”, and hence, has overcome the rejection of the recited dependent claims.

Paragraph 4 – Rejection under 35 USC §102(b)

In Paragraph 4, the patent examiner has rejected claims 30-34 as being anticipated by the ‘856 Patent to Emmerich et al. As amended, claim 30 recites that the sleeve is “non-rotatable” and that the wear sleeve is adapted to be non-rotatably received in the cavity bore. The principal focus of the patent examiner’s remarks is on FIG. 7. It appears that the structure shown in FIG. 7 of the ‘856 Patent is a rotatable member. In this regard, at Column 3, lines 29-32 the structure of FIG. 7 is termed another form of a “rotating” sleeve. Applicant submits that the patent examiner cannot use the rotatable sleeve of the ‘856 Patent to address the non-rotatably sleeve of the claims. This is a distinction that renders the rejection of claims 30-34¹ under 35 USC §102(b) without merit.

Paragraph 5 – Rejection under 35 USC §102(b)

In Paragraph 5 of the Office Action, the patent examiner rejected claims 30-34 as being anticipated by the ‘437 Patent to Crosby. Claim 30 requires, in part, that the split portion of the sleeve has an external surface of “substantially uniform diameter”. The principal focus of the patent examiner’s comments is on FIG. 5. A review of FIG. 5 of the ‘437 Patent shows that the sleeve 44 has protuberances 46 at the rear end thereof.

¹ Claims 31-34 depend in some fashion from claim 30 and are allowable for the reasons expressed in support of the allowance of claim 30.

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These protuberances establish that the rearward portion of the sleeve (44) does not have an external surface that has "substantially uniform diameter". Applicant respectfully submits that the '437 Patent does not anticipate claims 30-34², and hence, the rejection must fail.

Paragraph 6 – Rejection under 35 USC §102(b)

Claims 25, 27 and 30-34 stand rejected as being anticipated by the '012 Patent to Krekeler. The independent claims under rejection; namely, claims 25 and 30, each require that when the protective wear sleeve is within the cavity bore, the split portion of the sleeve exerts a radial force component against the cavity bore. One principal focus of the patent examiner's comments is on FIG. 18. A review of the structure illustrated in FIG. 18 and the accompanying description at Column 13, lines 50-75 shows the presence of two splits that form a detent wherein this detent does not provide a feature that facilitates the frictional retention of the sleeve in the bore, i.e., when the protective wear sleeve is within the cavity bore the split portion of the sleeve exerts a radial force component against the cavity bore. Hence, applicant submits that this rejection of these claims cannot stand in light of the absence of the above-mentioned claim recitations of claims 25 and 30³.

Paragraph 7 - Rejection under 35 USC §102(b)

Claims 25, 27 and 30-34 stand rejected as being anticipated by the '550 Patent to Beebe. The independent claims under rejection; namely, claims 25 and 30, each require

² Claims 31-34 depend in some fashion from claim 30 and are allowable for the reasons expressed in support of the allowance of claim 30.

³ Claim 27 depends from claim 25 and is allowable for all of the reasons set forth in support of the allowance of claim 25. Claims 31-34 depend in some fashion from claim 30 and are allowable for the reasons expressed in support of the allowance of claim 30.

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that the intermediate portion have an external surface that has a substantially uniform diameter. A review of the structure in Beebe shows that the portion that is forward of the cylindrical portion with a split does not have an external surface of a uniform diameter. The '550 Patent to Beebe does not address the invention as claimed in claims 25 and 30, as well as in the dependent claims⁴ that depend in one way or another from these independent claims.

Paragraph 9 – Rejection under 35 USC §103(a)

By this rejection, the patent examiner has rejected claims 6, 8, 26, and 28-29 under 35 USC §103(a) over the '005 Patent to O'Neill in view of either the '012 Patent to Krekeler et al. or the '550 Patent to Beebe. For the reasons set forth below, applicant submits that there is no motivation to combine the '005 Patent with either one of the '012 Patent or the '550 Patent.

It is apparent that the '005 Patent shows a sleeve that exhibits a frictional fit within the bore of the holder and that the sleeve does not contain a split. It is the static dimensions of the sleeve relative to the dimension of the bore that provides the retention of the sleeve within the bore. There is no need to provide in the sleeve of the '005 Patent the splits that form the detent as in the '012 Patent so that there is no motivation to combine the '012 Patent with the '005 Patent. Further, the structure of the '550 Patent is a retainer that is of a relatively thin dimension and not a thicker sleeve as in the sense of the '005 Patent. Hence, there is no motivation to make the cut in the thicker sleeve of the '005 Patent, especially when the sleeve of the '005 Patent already has a structure so that it retains itself within the bore of the holder.

⁴ Claim 27 depends from claim 25 and is allowable for all of the reasons set forth in support of the allowance of claim 25. Claims 31-34 depend in some fashion from claim 30 and are allowable for the reasons expressed in support of the allowance of claim 30.

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For the above reasons, applicant submits that the rejection lacks merit since the combination under 35 USC §103(a) is improper.

Conclusion

Applicant believes that all of the rejections have been fully addressed by this Response.

Applicant submits that the claims are allowable for the reasons advanced above. If the Patent Examiner has any questions or disagrees with applicant's position and has suggestions to place the claims in form for allowance, applicant urges the Patent Examiner to contact the undersigned attorney (615-662-0100) or Mr. John J. Prizzi at (724-539-5331).



Respectfully submitted,

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